

REMARKS

This responds to the Office Action dated October 3, 2003. Claims 16, 31, 32, and 38 are amended, claims 1-15 are canceled; as a result, claims 16-38 are now pending in this application.

Affirmation of Election

Restriction to one of the following claims was required:

I. Claims 1-15, drawn to apparatus to control power distribution from a UPS, classified in class 713, subclass 300.

II. Claims 16-38, drawn to apparatus and method for expanding a computer interface, classified in class 710, subclass 101.

As provisionally elected by Applicant's representative, Marvin L. Beekman, on August 13, 2003, Applicant elects to prosecute the invention of Group II, claims 16-38.

The claims of the non-elected invention, claims 1-15, are hereby canceled. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

Reservation of the Right to Swear Behind References

Applicant reserves the right to swear behind any documents that are cited in a rejection under §§ 102(a), 102(e), 103/102(a), and 103/102(e). Statements distinguishing the claimed subject matter over the cited documents are not to be interpreted as admissions that the documents are prior art.

§112 Rejection of the Claims

Claim 30 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Applicant respectfully traverses the rejection. The Office Action states that the phrase "the bus control module controls a plurality of switches to control power from the UPS to a plurality of external devices" is unclear and cannot be ascertained (*see* Office Action page3). Figure 2 shows, and page 6 lines 1-3 of the specification explains, that the control and monitor module 26 controls a plurality of switches 22 which provide power. As explained further on page 6, lines 4-

5, this allows the module to leave any combination of the external devices powered. Applicant respectfully requests reconsideration and allowance of claim 30.

§102 Rejection of the Claims

Claims 16, 17, 18, 20, 28, 32-34, 36-38 were rejected under 35 U.S.C. § 102(e) for anticipation by Dickens et al. (US 6,549,966, "Dickens"). Applicant respectfully traverses the rejection. To anticipate a claim, a reference must teach every element of the claim.

Regarding claims 16-18, 20, and 28:

Applicant cannot find in Dickens, among other things, any disclosure of a bus control module connected to the upstream connector and to the at least one legacy expansion bus structure, wherein the bus control module is adapted to provide a protocol conversion between the serial bus protocol and the legacy bus protocol, and is adapted to provide power to the computer through the serial bus,

as presently recited or incorporated into the claims.

Regarding claim 31:

Applicant cannot find in Dickens, among other things, any disclosure of a bus control module connected to the upstream connector and to the PCI bus structure, wherein the bus control module is adapted to provide a protocol conversion between the USB protocol and the PCI bus protocol, and is adapted to provide power to the computer through the USB,

as presently recited in the claim.

Regarding claims 32-34, and 36-38:

Applicant cannot find in Dickens, among other things, any disclosure of a method including providing power to the computer through a serial communication bus, as presently recited or incorporated into claims 32-34, 36, and 37, or including providing power to the computer through the USB, as presently recited in claim 38.

Applicant respectfully requests reconsideration and allowance of claims 16, 17, 18, 20, 28, 32-34, and 36-38.

§103 Rejection of the Claims

Claims 19 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickens et al. Applicant respectfully traverses the rejections. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *M.P.E.P.* § 2143.03. Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. *37 C.F.R.* § 1.75.

Claims 19 ultimately depends on base claim 16, and claim 19 ultimately depends on base claim 32. Applicant believes claims 19 and 35 are allowable at least for the reason that Dickens fails to teach or suggest all elements of their base claim, namely claims 16 and 32. Applicant respectfully requests reconsideration and allowance of claims 19 and 35.

Claims 21-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickens et al. Applicant respectfully traverses the rejections. Claims 21-27 ultimately depend on base claim 16. Applicant believes claims 21-27 are allowable at least for the reason that Dickens fails to teach or suggest all elements of base claim 16.

Additionally, the Office Action states that Dickens does not disclose the expansion slot recited in claim 21, but that it would have been obvious to one of ordinary skill in the art to provide the device in Dickens with the expansion slot, and that the various connections to the legacy bus structure recited in claims 22-27 are notoriously old and well known in the art. However, to establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. *M.P.E.P.* § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Applicant submits that a mere assertion that something is "notoriously old and well known" is not proper motivation to establish a *prima facie* case of obviousness. As indicated in Lee 277 F.3d at 1343-44, 61 USPQ2d at 1433-34, the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied references must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record."

Applicant respectfully requests reconsideration and allowance of claims 21-27.

Claims 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickens et al. Applicant respectfully traverses the rejection. Claims 29 and 30 ultimately depend on base claim 16. Applicant believes claims 29 and 30 are allowable at least for the reason that Dickens fails to teach or suggest all elements of base claim 16.

Additionally, Dickens apparently includes no disclosure of a bus control module that controls a plurality of switches to control power from the UPS to a plurality of external devices as recited in claim 30. The Office Action states that it is clear that the device in Dickens controls electrical/logic switches to continue to provide power to a plurality of devices connected thereto in case of a sudden power failure so that data loss, for example, can be prevented (*see* Office Action page 7). However, Applicant cannot find any such disclosure in Dickens. Therefore, the assertion in the Office Action appears to be a conclusory statement not based on any objective evidentiary support of record. Applicant respectfully requests the Examiner to either provide a reference with the claimed features or to submit an affidavit (37 C.F.R. §1.104(d)(2)).

Applicant respectfully requests reconsideration and allowance of claims 29 and 30.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6960 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

ANDREW FRANK

By his Representatives,


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Date 8-22-05

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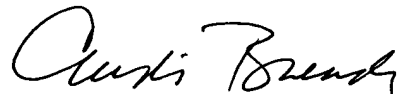
AUG 26 2005

OFFICE OF PETITIONS

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Petition, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of August, 2005.

CANDIS BUENDING

Name



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